

III. Remarks

A. Amendments to the Claims

All of the remaining claims 46, 57–58, 61 and 63–70 consist of or incorporate the subject matter of claim 62. For example, claim 46 has been rewritten to incorporate the limitations of claim 62.

B. Rejections under 35 U.S.C. § 102

1. **Rejection of claims 46, 48–53, 55–57, 61 and 64 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,750,563 to Honda**
2. **Rejection of claims 67–70 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,322,689 to Hughes et al.**

Neither of these rejections includes claim 62. As noted above, all of the claims that are now pending in the application have been amended to incorporate the subject matter of claim 62. These rejections have been rendered moot by the amendments to the claims and should be withdrawn.

C. Rejections under 35 U.S.C. § 103

1. **Rejection of claims 56 and 65 under 35 U.S.C. § 103(a) as being unpatentable over the combined disclosures of United States Patent No. 5,750,563 to Honda, United States Patent No. 5,879,683 to Hamilton-Miller and United States Patent No. 5,416,075 to Carson et al.**

The rejection does not include claim 62. Accordingly, for the reasons set forth above with regard to the rejections under 35 U.S.C. § 102, the rejection has become moot and should be withdrawn.

**2. Rejection of claims 62, 63 and 66 under 35 U.S.C. § 103(a)
as being unpatentable over United States Patent
No. 5,750,563 to Honda**

(a) Reasons for the rejection

The Examiner's reasons for the rejection are as follows:

As discussed above the '563 reference discloses a formulation comprising lactic acid, and polyphenols. The reference discloses the concentration of the polyphenols but is silent [as] to the lactic acid concentration. However, applicant is reminded that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See *In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).

(Examiner's Action at Paragraph 14, page 5).

**(b) Comparison between Applicant's claimed invention
and the '563 patent**

As noted above, Applicant's claimed invention is directed to an antimicrobial composition consisting essentially of a mixture containing defined weight percents of tannins and tannic acid and of lactic acid, the mixture containing no other generally recognized as safe flavored alcohols. The other pending claims 57–58, 61 and 63–70 also include the limitation now set forth in claim 46.

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not *materially* affect the *basic* and *novel* characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551–52, 190 USPQ 461, 463 (CCPA 1976) (*emphasis in original*). (M.P.E.P. 2111.03).

The '563 patent is directed to a preparation for epidermis containing kojic acid and/or its derivative and at least one member selected from the group consisting of alcohols and polyphenols (See '563 patent, Abstract and Summary of the Invention at Column 2, lines 15–24). Kojic acid is defined as 5-hydroxymethyl-y-pyrone (Col. 2, lines 32–33). It is not a tannin or tannic acid. Nor is kojic acid equivalent to lactic acid. Applicant's composition, as claimed in claim 46, cannot include kojic acid as kojic acid would materially affect the basic and novel characteristics of Applicant's claimed composition.

As Applicant's claimed composition does not include kojic acid, whereas kojic acid is an essential ingredient of the preparation set forth in United States Patent No. 5,750,563, the patent does not render the claims obvious. Because kojic acid is an essential ingredient in the preparations disclosed in United States Patent No. 5,750,563, a *prima facie* case of obviousness cannot be made by reliance on the preparation disclosed in the patent as modified by the removal of the kojic acid. The object of the patented invention is to provide a preparation for epidermis which solves problems experienced with conventional kojic acid-containing preparations. The preparation disclosed in the patent must include kojic acid in order to treat epidermis. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended use, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (M.P.E.P. § 2143.01).

A removal of kojic acid from the preparation of the prior art reference would also change the principle of operation of that reference as the reference discloses a preparation containing kojic acid. If the proposed modification or a combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference[s] are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (M.P.E.P. § 2143.01).

Accordingly, for the reasons set forth above, there is no *prima facie* case of obviousness of the pending claims 46, 57–58, 61 and 63–70 over United States Patent No. 5,750,563. Accordingly, the rejection of those claims under 35 U.S.C. § 103(a) as unpatentable over United States Patent No. 5,750,563 is untenable and should be withdrawn.

Response
to Office Action of January 30, 2006

PATENT
Serial No. 09/743,883; Filing Date January 16, 2001
Examiner Charesse L. Evans; Art Unit 1615
Attorney Docket No. von Kreisler.011

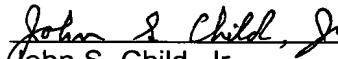
IV. Conclusion

It is believed that the above Amendment and Remarks constitute a complete Response under 37 C.F.R. § 1.111 and that all grounds for objection stated in the Action have been adequately rebutted or overcome. A Notice of Allowance in the next Action is therefore requested. The Examiner is requested to telephone the undersigned counsel if any matter that can be expected to be resolved in a telephone interview is believed to impede the allowance of the pending claims of Application Serial No. 09/743,883.

Respectfully submitted,

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Enclosures: Request for Continued Examination Transmittal
Certificate of Mailing Under 37 C.F.R. § 1.8(a)
Petition for Extension of Time Under 37 C.F.R. § 1.136(a)
Authorization To Charge Deposit Account (original + 1 copy)
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